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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,836	10/31/2003	Philip Carbone	SGS-101-DIV3	1276
42419	7590	11/17/2004	EXAMINER	
PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60195			LU, JIPING	
			ART UNIT	PAPER NUMBER
			3749	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/698,836	Applicant(s) CARBONE ET AL.	
	Examiner Jiping Lu	Art Unit 3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 31-37 is/are pending in the application.
- 4a) Of the above claim(s) 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 1-30 are canceled. Claims 31- 37 are pending in the case. Non-elected claims 36-37 stand withdrawn from consideration.

### *Claim Rejections - 35 USC § 102 or 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 31 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Brandt et al. (U. S. Pat. 5,797,358) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brandt et al. (U. S. Pat. 5,797,358) in view of Boros et al. (U. S. Pat. 5,941,200).

Brandt et al. shows a gaseous fuel fired water heater apparatus having a bottom wall (not numbered, at 122) at least partially defining a combustion chamber, a fuel supply 128 and an air supply 122, exhaust flue 130, a plurality of burner assemblies with burners 120 which are arranged same as claimed. The burners in Brandt et al. may be considered to be “quickly connected” burners. Or alternative, Boros et al. show a quick connection mounting apparatus for releasable attaching a burner assembly 52, 68 to a bottom wall 48 that at least partially defines a combustion chamber 18 of a water heater 10 comprising a flange 52 on the burner assembly and a removable screw 64 for fastening a second end of the flange against the bottom wall 48 same as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the

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time the invention was made to modify the water heater of Brandt et al. to include a burner assembly mounting apparatus as taught by Boros et al in order to facilitate a quick connection.

*Claim Rejections - 35 USC § 103*

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. (U. S. Pat. 5,797,358) in view of Bishop (U. S. Pat. 189,421).

The fuel fired water heater of Brandt et al. as above includes all that is recited in claims 32-33 except for the burner assemblies are positioned a distance apart from each other forming a catch area between the burner assemblies. Bishop teaches a water heater with burner assemblies J are positioned a distance apart from each other same as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the burner assemblies of Brandt et al. a distance apart from each other as taught by Bishop in order to improve the water heater efficiency. It is inherent for the water heater that a catch area is formed between the burner assemblies when the burner assemblies are placed a distance apart from each other.

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. (U. S. Pat. 5,797,358) in view of Boros et al. (U. S. Pat. 5,941,200) and Taylor et al. (U. S. Pat. 4,397,299).

Brandt et al. shows a gaseous fuel fired water heater apparatus having a bottom wall (not

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numbered, at 122) at least partially defining a combustion chamber, a fuel supply 128 and an air supply 122, exhaust flue 130, a plurality of burner assemblies with burners 120 which are arranged same as claimed. Boros et al. show a mounting apparatus for releasable attaching a burner assembly 52, 68 to a bottom wall 48 that at least partially defines a combustion chamber 18 of a water heater 10 comprising a flange 52 on the burner assembly and a removable screw 64 for fastening a second end of the flange against the bottom wall 48 same as claimed. Taylor et al. teach a mounting apparatus for releasable attaching a burner assembly 70, 80 to the bottom wall 74, 76 comprising a clip 72, 78 with a base portion attached to the bottom wall and an end portion offset from the base forming a receiver for engaging the flange portion 120 of the burner 70,80 same as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the water heater of Brandt et al. to include a burner assembly mounting apparatus as taught by Boros et al. and to further modify the burner assemblies mounting apparatus to include a clip 72,78 of Taylor et al. in order to facilitate the installation of burner assembly to the water heater combustion chamber bottom wall.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claim 34 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23, 29 of copending Application No. 10/699,464. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a mounting apparatus for releasably attaching a burner assembly to a bottom wall of the combustion chamber of a water heater with a clip having an end portion spaced from the bottom wall forming a receiver, a first portion of the flange engageable within the receiver and a removable fastener fastening a second end of the flange against the bottom wall.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

6. Applicant's arguments filed 8/23/2004 have been fully considered but they are not persuasive. First, broad claims presented fail to structurally define over the art. Claim 31 merely calls for a quick connection without claiming any specific structure. Therefore, the burners in Brandt et al may be considered to be "quickly connected" burners. The patents to Boros et al and Taylor do show a quick connections same as the applicant's. Second, the applicant has argued each and every reference but failed to recognize the combined teachings of the prior art references that render the broadly claimed invention obvious.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

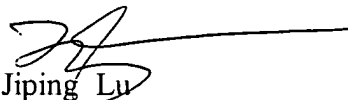
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jiping Lu whose telephone number is 703-308-2354. The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ira Lazarus can be reached on 703 308-1935. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jiping Lu  
Primary Examiner  
Art Unit 3749

J. L.